



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,468	04/08/2004	John Walter Locher	1075-BI4324	7574
34456	7590	07/28/2005	EXAMINER	
TOLER & LARSON & ABEL L.L.P. 5000 PLAZA ON THE LAKE STE 265 AUSTIN, TX 78746			STEIN, STEPHEN J	
		ART UNIT		PAPER NUMBER
		1775		

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/820,468	LOCHER ET AL.
Examiner	Art Unit	
Stephen J. Stein	1775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 23 June 2005.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-61 is/are pending in the application.
4a) Of the above claim(s) 16-61 is/are withdrawn from consideration.
5) Claim(s) _____ is/are allowed.
6) Claim(s) 1-15 is/are rejected.
7) Claim(s) _____ is/are objected to.
8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/21/05.
4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. .
5) Notice of Informal Patent Application (PTO-152)
6) Other: .

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse Group I in the reply filed on June 23, 205 is acknowledged. The traversal is on the ground(s) that examination of all of the claims is not believed to create an undue burden on the USPTO and the subject matter is not independent and distinct as required by statute. This is not found persuasive. First, MPEP 806 (b) recites that "Where inventions are related as disclosed but are distinct as claimed, restriction may be proper". Therefore, claimed inventions may be restricted even if they are related when they are distinct. The Group I and Group II claims were indicated by the examiner who made the restriction as related in a Process of Making and Product Made relationship. In this case the examiner who made the restriction requirement asserted a materially different process for making the claimed product. The Group I and Group III claims were related as being in a apparatus and product made relationship. In this case, the examiner asserted that the the apparatus as claimed can be sued for making a materially different product. Finally, the Group II and Group III claims were indicated as releted in a process and apparatus for it's practus relationship. In this case, the examiner asserted that the apparatus as claimed can be used in a materially different process. Therefore the examiner has met the *prima facie* burden of showing the three grouped inventions (I, II and III) are distinct. Applicants have provided no evidence nor explained why the asserted materially different products or process could not be used to make the claimed product or process. Consequently, the assertion of distinctiveness of the claimed inventions remains valid. Finally, with regard to the argument that there is no serious burden on the examiner to examine the three groups, it pointed to applicants that in the restriction requirement the examiner has

shown that subject matter of the two groups encompass two different statutory classes of invention each having a different classification. For purposes of the initial requirement of a restriction, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in MPEP § 808.02

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 5 recites the limitation, "The crystal of claim 1, wherein the thickness is no less than about 0.7cm (0.8, 0.9 in spec)". The limitation "(0.8, 0.9 in spec)" makes the claim indefinite, because it is unclear as to the scope of protection being sought.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 57095899A (Takahashi et al.).

Takahashi teaches a sapphire single crystal sheet applicable to the optical and electronic industries (See abstract). Although Takahashi fail to teach the claimed width, length, thickness, variations of thickness and shape (all result effective variables) of the claimed sapphire single crystal sheet, absent a showing of criticality with respect to the claimed width, length, thickness, variations of thickness and shape, it would have been obvious to one of ordinary skill in the art at the time of the invention to optimize these parameters through routine experimentation in order to create multiple SOS substrates for electronic applications, or desired window plates for UV rays. It has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Stein whose telephone number is 571-272-1544. The examiner can normally be reached on Monday through Friday from 8:30 a.m. to 5:00 p.m. If the attempts to reach the examiner are unsuccessful, the examiner's supervisor, Deborah Jones can be reached by dialing 571-272-1535. The official fax number is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Art Unit: 1775

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

July 23, 2005


Stephen J. Stein
Primary Examiner
Art Unit 1775